



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,169	08/30/2006	Frederic A. Macdonald	2596001US2AN	6063
27542 7590 11/24/2010 SAND & SEBOLT AEGIS TOWER, SUITE 1100 4940 MUNSON STREET, NW CANTON, OH 44718-3615				
EXAMINER				
RAVETTI, DANTE				
ART UNIT		PAPER NUMBER		
3685				
MAIL DATE		DELIVERY MODE		
11/24/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,169

Applicant(s)

MACDONALD ET AL.

Examiner

DANTE RAVETTI

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 1-40 and 49-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-48 and 58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date _____
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This communication is in response to the Request for Continued Examination of Application No. 10/591,169, filed on 13 May 2009.
2. Claims 41-48 and 58 are currently pending and have been fully examined.
3. Claims 49-57 have been withdrawn by the Applicant.
4. Claims 1-40 have been cancelled by the Applicant.
5. For the purpose of applying the prior art, PreGrant Publications will be referred to using a four digit number within square brackets, e.g. [0001].

Response to Applicant's Amendments/Remarks

6. Applicant's remarks, filed on 13 May 2009, has fully been considered, but are moot in light of new grounds of rejection necessitated by Applicant's new limitations.

In light of Applicant's choice to pursue method claims, Applicants are also reminded that functional recitations using the word "for," "configured to," or other functional terms¹ (e.g. see claim 1, which recites, "...to receive digital media content...non-profit organization for sale for fundraising...") have been considered but are not given patentable weight² because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered; however, a recitation of the intended use in a method claim must result in a structural difference between the claimed product and the prior art in order to

¹ MPEP §2106 II C;

² In re Gulack, 703 F. 2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight);

patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation.³ Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

Clauses (e.g. whereby, thereby, wherein) that merely states the result of the limitation(s) of a claim(s) does not limit the scope of the claim(s).⁴ Therefore, as recited in claim 42, wherein the retailer includes a plurality of retailers will not limit the scope of the claim.

Claim 43 contains similar language found in claim 42.

Examiner would like to point out that the language of claim 44, and in others, describes, "non-functional descriptive material." For example, as to claim 44, Applicant recites, "wherein each of the vouchers includes a corresponding value associated therewith;" However, this is an example of non-functional descriptive material.⁵

Examiner would also like to point out that Official Notice was used in the previous office action mailed on 13 November 2008 to indicate that the ability to track vouchers and activated vouchers is an old and well known practice in the art.⁶ Since Applicant

³ In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself."); In re Otto, 136 USPQ 458, 459 (CCPA 1963); Ex parte Masham, 2 USPQ2d 1647 (1987); A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform.

See also MPEP §§ 2114 and 2115.

⁴ MPEP §2106 II C; MPEP §2114;

⁵ In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability ...[T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate;

⁶ Walker et al., (US 2005/0182678); [0163] Generally, in various embodiments, a vending machine processor receives a signal from a vending machine input device (e.g., a keypad, a touch screen, a bar code scanner), where

has not attempted to traverse this Official Notice statement, Examiner is taking the common knowledge or well-known statement to be admitted prior art.⁷

Continued Examination Under 37 C.F.R.- §1.114

7. A request for continued examination under 37 CFR §1.114, including the fee set forth in 37 CFR §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR §1.114, and the fee set forth in 37 CFR §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR §1.114. Applicant's submission filed on 13 May 2009 has been entered.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 41-48 and 58 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent⁸ and recent Federal Circuit decisions, a §101 process must (1) be tied to another particular apparatus/machine or (2) transform the underlying subject matter (such as an article or materials) to a different state or

that signal indicates a request to activate a voucher. In some embodiments, one or more databases are used to track whether a voucher is active (as well as, e.g., whether the voucher has been redeemed or has expired). Thus, the database may be consulted such that recipients presenting valid vouchers are provided with appropriate gifts, while recipients presenting inactive or otherwise invalid voucher identifiers are not.

⁷ See MPEP 2144.03 C;

thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity.⁹

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other particular apparatus/machine to which it is tied. This may be accomplished by having the claim positively recite the apparatus/machine that accomplishes the method steps.

Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 41 fails prong (1) because there exist no "tie" to another particular apparatus/machine to perform the following steps of:

creating a plurality...

providing the plurality...

storing, in the....

collecting funds from...

receiving from the...

identifying...

providing to the retailer...

Therefore, claim 41 does not meet the requirements of the first prong (1).

⁸ See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876);

⁹ *Bilski v. Kappos*, 95 USPQ2d 1001 (US 2010);

Additionally, the claim(s) 41 fails prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claims 42-48 and 58 are also rejected for being dependent upon rejected claim 41. The appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 43 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claim 43, Applicant recites:

deducting the cost from the value associated with a voucher corresponding to the at least one unique identifier to determine a second value; and

storing the second value in the accounting system in association with the at least one voucher.

In regards to, "cost" Applicant's Specification recites:

[0034] The system and method may also provide unique and practical incentives on many levels such as providing suitable ease of use and attractive results for meeting performance goals of organization's fundraising endeavors. For example, these incentives may include but not limited to the following: [0035] Low-cost/easy-to-implement: Mass production and distribution costs of digital music are minimal (unlike physical items or one-off fund-raising events), and there is no up-front production costs or physical inventory to maintain. [0036] Incremental income: With extensive ties to the community, the partner organizations are typically able to provide local and national outreach to consumers such as evangelizing the inevitable distribution and format shift from CDs to digital music downloads. The organizations may also give the music labels a significant spike in digital music sales while also enabling the facilitator to structure partnerships with music labels in order to direct a significant and ongoing percentage of the music revenue to partner organizations and other organizations. The net result might result in millions of dollars in

revenue on an ongoing basis for the organizations. [0037] Broad appeal: Music appeals to people of all ages, religions and cultural groups. Increasingly, people of all ages now own, operate and are comfortable with computers and the Internet. One concern that many people still have is the use of credit cards on the Internet, and this concern might be eliminated in embodiments of the invention by allowing for face-to-face purchases from trusted members of the fund-raising organization, or other similar organization. In other embodiments of the invention, parents may be motivated to buy music online with their children using the parent's credit card, allowing parents to guide their children's music purchases. Regardless of the embodiment, the invention supports the message that file sharing is illegal and punishable by law. [0038] Public service: For years, the music labels have been struggling to educate and dissuade the public from illegally downloading and sharing digital music. Unfortunately, the music industry's prevention program has largely been conducted through somewhat negative methods, e.g., warnings, legal action and associated press releases. Instead of intimidating and ostracizing consumers, the invention becomes part of the overall solution, reinforcing the value of digital music, and enabling organizations to benefit directly from each sale. An educational program aimed at all of the organization's members and customers to emphasize the dangers of illegal downloading may be viewed very positively by the organizations, the Artists and the Music Labels. Accordingly, educational modules or components may be provided in methods according to the invention. [0039] Clean Content: Whereas parents who let their children download music from the Internet without the invention run the risk of having their children encounter content, like songs, that have explicit lyrics or content. However, embodiments of this invention may provide the music store to serve a "clean version" (e.g., filtered of explicit material) of the store to all users of song cards, since the distribution is more tightly controlled. This will give parents a safe way to let their kids download content online.

Applicant's Specification seems to be silent Applicant's limitation of deducting the cost from the value associated with a voucher corresponding to the at least one unique identifier to determine a second value; and storing the second value in the accounting system in association with the at least one voucher.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 41-48 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hileman et al., (US 2004/0114766) ("Hileman") and in view of Karas et al., (US

2003/0130907) ("Karas").

As to claim 41:

Hileman teaches substantially as claimed:

creating a plurality of vouchers, each of the vouchers including a corresponding unique identifier and each of the vouchers being redeemable at a retailer to receive digital media content controlled by the retailer ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

providing the plurality of vouchers to the non-profit organization for sale for fundraising ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

storing, in an accounting system, the unique identifiers corresponding to the plurality of vouchers provided to the non-profit organization ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

receiving from the non-profit organization at least one unique identifier corresponding to at least one voucher to be activated ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

identifying vouchers in the accounting system corresponding to the at least one unique identifier as being activated ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

providing to the retailer information relating to vouchers identified in the accounting system as being activated ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

receiving from the retailer at least one unique identifier corresponding to at least one voucher to be redeemed ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

collecting funds from the non-profit organization relating to the plurality of vouchers ([0035]-[0041]);

Hileman does not expressly teach:

providing funds to the retailer relating to vouchers which are redeemed.

However, Karas expressly teaches:

providing funds to the retailer relating to vouchers which are redeemed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hileman to include the features of Karas because in order to process gift cards, between a plurality of different parties, for a plurality of different types of transactions, providing funds between different parties may be necessary to assist in the completion of the transaction.

As to claim 42:

Hileman expressly teaches:

wherein the retailer includes a plurality of retailers ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

As to claim 43:

Hileman expressly teaches:

wherein the retailer includes an on-line retailer ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

As to claim 44:

Hileman expressly teaches:

wherein each of the vouchers includes a corresponding value associated therewith ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

wherein the storing step includes storing a value associated with each of the vouchers ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23); and

wherein the step of receiving from the retailer at least one unique identifier includes the steps of ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

receiving from the retailer a cost associated with digital media content provided with redemption of the at least one voucher (Abstract, [0005]-[0006], [0008], [0010]-[0013], [0034], Claims 1, 9);

deducting the cost from the value associated with a voucher corresponding to the at least one unique identifier to determine a second value ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23); and

storing the second value in the accounting system in association with the at least one voucher ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

As to claim 45:

Hileman expressly teaches:

wherein each voucher includes a card having a corresponding unique identifier provided thereon ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

As to claim 46:

Hileman expressly teaches:

receiving from the retailer a first unique identifier corresponding to a voucher to be redeemed ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

determining from the accounting system whether the voucher corresponding to the first unique identifier had been activated ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23); and

reporting to the retailer whether the voucher corresponding to the first unique identifier had been activated ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

As to claim 47:

Hileman expressly teaches:

wherein the step of receiving from the non-profit organization at least one unique identifier includes the steps of:

receiving a phone call communication at an automated activation unit ([0002], [0039], Claim 4); and

receiving through the phone call communication the at least one unique identifier ([0002], [0039], Claim 4);

As to claim 48:

Hileman expressly teaches:

wherein each of the unique identifiers includes a first partial identifier and a second partial identifier ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23); and

wherein the step of providing the plurality of vouchers to the non-profit organization includes the steps of providing each first partial identifier to the non-profit organization ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23); and

providing each second partial identifier to the non-profit organization separately from the first partial identifiers ([0008]-[0011], [0013], [0020]-[0021], [0027], [0030]-[0031], [0035]-[0041], [0043], Claims 8, 12, 13, 23);

As to claim 58:

Hileman expressly teaches:

wherein the communication is a phone call ([0002], [0039], Claim 4);

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to

Applicant's disclosure.

Walker et al., (US 2005/0182678); [0163] Generally, in various embodiments, a vending machine processor receives a signal from a vending machine input device (e.g., a keypad, a touch screen, a bar code scanner), where that signal indicates a request to activate a voucher. In some embodiments, one or more databases are used to track whether a voucher is active (as well as, e.g., whether the voucher has been redeemed or has expired). Thus, the database may be consulted such that recipients presenting valid vouchers are provided with appropriate gifts, while recipients presenting inactive or otherwise invalid voucher identifiers are not.

Any inquiry concerning this communication or earlier communication from
the examiner should be directed to Mr. Dante Ravetti whose telephone number is

(571) 270-3609. The examiner can normally be reached on Monday – Thursday 9:00am-5:00pm.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Calvin Hewitt may be reached at (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is (571) 270-4609.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, please contact the Electronic Business Center (EBC) at 1-(866) 217-9197. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 1-(800) 786-9199 (IN USA or CANADA) or 1-(571) 272-1000.

/Dante Ravetti/
Examiner, Art Unit 3685
Friday, November 19, 2010

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685